

1 Yitai Hu (SBN 248085)
2 Sean P. DeBruine (SBN 168071)
3 Elizabeth H. Rader (SBN 184963)
4 S. H. Michael Kim (SBN 203491)
5 AKIN GUMP STRAUSS HAUER & FELD, LLP
6 Two Palo Alto Square
7 3000 El Camino Real, Suite 400
8 Palo Alto, CA 94306-2112
9 Telephone: (650) 838-2000
10 Facsimile: (650) 838-2001
11 Email: erader@akingump.com

12 Attorneys for Defendant
13 REALTEK SEMICONDUCTOR CORP.

14
15 UNITED STATES DISTRICT COURT
16
17 NORTHERN DISTRICT OF CALIFORNIA
18
19 SAN FRANCISCO DIVISION

20 3COM CORPORATION,
21
22 Plaintiff,

23 v.

24 D-LINK SYSTEMS, INC.

25 and

26 REALTEK SEMICONDUCTOR CORP.,

27 Defendants.
28

Case No. CV-03-2177-VRW

**REALTEK'S REPLY IN SUPPORT OF
MOTION FOR SUMMARY JUDGMENT
OF INVALIDITY**

Judge: Vaughn R. Walker
Date: December 20, 2007
Time: 2:30 p.m.
Courtroom: 6, 17th Floor

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1 **I. INTRODUCTION**

2 3Com's Opposition to Realtek's Motions for Summary Judgment of Invalidity ("Opp'n.") can
3 be explained only as the act of a desperate party. Only desperation can explain 3Com's sudden
4 presentation of a claim construction argument, namely that all of the asserted claims of the '459, '872
5 and '094 patents are limited specifically to network adapters for Ethernet networks. 3Com did not
6 timely raise that position during claim construction and its expert's report and deposition testimony
7 reveal no such contention. More importantly, there is absolutely no basis for that argument. With the
8 exception of two, the claims contain no such express limitation. The patents mention Ethernet only in
9 passing, and then with reference only to a preferred embodiments. In addition, 3Com raises this new
10 and unsupported claim construction in order to argue that its patent claims are different than the FDDI
11 network disclosed as the preferred embodiment in the prior art Firoozmand patents. However, 3Com
12 essentially admits that the disclosure of the Firoozmand patent is not limited to FDDI networks. Thus,
13 the alleged differences between these network standards is irrelevant to the invalidity of most of the
14 asserted claims. Yet 3Com devotes a large portion of its brief, and its expert devotes fully seven pages
15 of his declaration to this issue. Because this purported limitation is non-existent in all but two of the
16 claims, the vast majority of 3Com's brief, and its expert's declaration, are irrelevant and must be
17 disregarded.

18 Only desperation can explain 3Com's many other attempts to argue that claim elements are
19 missing from the prior art based on interpretations of other of the asserted claim limitations that
20 directly contradict this Court's claim construction order. Only desperation can one explain 3Com's
21 expert proposing an entirely new basis for his opinion that the Muller II prior art does not anticipate the
22 '884 patent not disclosed in his expert report or mentioned in his deposition. Because the substance of
23 that opinion was never set out in his expert report, and Realtek was denied any opportunity to cross-
24 examine him on the basis or rebut that new opinion, it should be stricken from the record and
25 disregarded.

26 3Com clearly raises these new, unsupported and irrelevant arguments as a smoke screen to hide
27 the clear invalidity of these claims. Among the glaring shortcomings in 3Com's opposition is its
28 complete failure to meet its burden of presenting admissible evidence necessary to establish diligence

1 by 3Com in reducing it alleged inventions to practice. As a result of that failure, the Firoozmand
2 patents and the Muller II patent are established as prior art as a matter of law. 3Com's smokescreen
3 likewise fails to establish that any other actual claim limitations are missing from the disclosure of the
4 prior art. As such, Realtek is entitled to summary judgment that these patent claims are invalid as it
5 requests.

6 **II. ARGUMENT**

7 **A. 3Com Raises No Genuine Issues To Prevent Summary Judgment Of Invalidity of** 8 **the '459, '872 and '094 Patents (the "Parallel Tasking" Patents).**

9 **1. The Firoozmand Patents Are Prior Art**

10 3Com devotes three full pages of its opposition in an attempt to show that its inventors
11 conceived of the "parallel tasking" patent claims before Mr. Firoozmand. As discussed below, that
12 effort fails. However, that issue is not necessary for the Court's entry of summary judgment that these
13 claims are invalid. That is because, even if the court concludes that there is an issue of fact regarding
14 the date of conception, the Firoozmand patents are nevertheless prior art to the asserted 3Com patents
15 as a matter of law. As the second party to reduce the claimed inventions to practice, 3Com bears the
16 burden of establishing its diligence in reducing the claimed inventions to practice. *Mahurkar v. C.R.*
17 *Bard, Inc.*, 79 F.3d 1572, 1576 (Fed. Cir. 1996). 3Com proffers no admissible testimony on which a
18 trier of fact could conclude it was diligent.

19 The applications for the 3Com patents were filed on July 28, 1992. Absent sufficient
20 corroborated evidence of an earlier actual reduction to practice, 3Com must show diligence during the
21 entire time from May 1990 to July 1992. 3Com fails to adduce any admissible evidence sufficient to
22 demonstrate either an earlier actual reduction to practice or the required diligence. First, 3Com
23 relegates this dispositive issue to a footnote. Opp'n at 5, n. 7. It claims a reduction to practice on
24 November 26, 1991 but provides no admissible evidence to support that statement. Rather, it relies on
25 a declaration made by two of the inventors during the prosecution of the patent. Cole Decl., Ex. 3 at
26 ¶ 15. That conclusory statement is itself based on hearsay ("I am informed and believe") and is made
27 in an uncorroborated document that is inadmissible hearsay. As such the Court may not consider that
28 document as evidence in for purposes of summary judgment. Even if admissible and accepted as true,
that statement fails to establish that the alleged prototype included every element of the asserted patent

1 claims, or if so, that it was found to work for its intended purpose. Moreover, the statement of the
2 inventors is not corroborated by any evidence whatsoever. As such, 3Com fails to provide any
3 evidence regarding a reduction to practice prior to July, 1992.

4 Similarly, 3Com comes forward with no admissible evidence establishing any facts necessary
5 to show diligence. Rather, it offers statements by Mr. Verhalen and Mr. Petersen that are no more than
6 legal conclusions. Those statements simply aver that the inventors and “others” were diligent. There
7 is not even an acknowledgement of the period of time covered by that alleged diligence. Verhalen
8 Decl., ¶ 10; Scherer Decl., ¶ 9; 3Com was required to come forward with evidence showing the
9 inventor’s activities during the entire period from just before Mr. Firoozmand’s conception date until
10 their own reduction to practice. *Monsanto Co. v. Mycogen Plant Sci., Inc.*, 261 F.3d 1356, 1362-63
11 (Fed. Cir. 2001). That evidence must show that the inventors devoted themselves substantially and
12 continuously to those efforts, and must account for all of the time in the diligence period. *Id.* at 1369.
13 Rather than even attempting to meet that burden, 3Com relies on statements that are devoid of any
14 facts. Rather, they merely parrot a legal conclusion. They do not even discuss the relevant period,
15 much less account for the inventors’ activities during that period. 3Com has therefore failed to meet its
16 burden of producing competent evidence. *See Chen v. Bouchard*, 347 F.3d 1299 (Fed. Cir. 2003)
17 (party who provided no evidence of who worked on the project on what days for any day in the period
18 failed to meet burden of showing diligence). Because there is **no** evidence upon which a reasonable
19 trier of fact could conclude that 3Com’s inventors were diligent during the crucial period, as a matter
20 of law the Firoozmand patents are prior art.

21 Even setting aside 3Com’s dispositive failure to meet its burden of producing admissible evidence on
22 diligence, the evidence is clear, convincing and not rebutted that Farzin Firoozmand was the first to
23 invent the subject matter of the asserted claims of the ’872, ’094 and ’459 patents. 3Com again fails to
24 come forward with sufficient evidence to avoid summary judgment on this point. First, 3Com
25 misstates the quantum of evidence required to establish Mr. Firoozmand’s date of conception. 3Com
26 is mistaken with regard to the standard of proof required to establish Mr. Firoozmand’s earlier
27 invention. Mr. Firoozmand’s patents were applied for on May 29, 1990. Firoozmand I issued on May
28 11, 1993, while Firoozmand II issued on January 30, 1996. The 3Com “parallel tasking” patents were

1 applied for on July 28, 1992 and issued between 1994 and 1998. Declaration Of Farzin Firoozmand in
2 Support of Realtek's Alternative Motion For Summary Judgment of Invalidity of The '872 And '094
3 Patents ("Firoozmand '872 and '094 Decl."), Ex. 6 ('872) and 7 ('094); Declaration of Ming-Tao Yang
4 in Support of Realtek's Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,307,459
5 ("Yang '459 Decl."), Ex. A ('459).

6 As such, the applications for the 3Com parallel tasking patents and the Firoozmand patents
7 were co-pending before the PTO. On these facts, the proper burden of proof is the preponderance of
8 the evidence. Where two parties have co-pending applications directed toward the same subject mater,
9 the priority of the claimed inventions is determined based on the preponderance of the evidence.
10 *Environ Prods., Inc. v. Furon Co.*, 215 F.3d 1261, 1266 (Fed. Cir. 2000). On that standard there is no
11 question that Mr. Firoozmand was the first inventor.

12 Mr. Firoozmand filed at least two patent applications on May 29, 1990. Firoozmand '872 and
13 '094 Decl.", Ex. 1 and 2. Those applications serve as a constructive reduction to practice of the
14 inventions they disclose. *Hazeltine v. United States*, 820 F.2d 1190 (Fed. Cir. 1989). Mr. Firoozmand
15 provides the following to corroborate his invention date. His inventions were conceived of while he
16 was employed at AMD, and his patents are assigned to AMD. Mr. Firoozmand left AMD's employ in
17 1989. He completed his invention disclosure form to begin the process of applying for his patents in
18 May, 1989. Based on the totality of the circumstances, the only reasonable conclusion to draw from
19 this evidence is that his conception was complete no later than May 15, 1989.

20 3Com presents no evidence to establish an earlier date. Its inventors and others make vague
21 references to meetings occurring between mid-1988 and mid-1989. *See* Connery, Peterson, Sherer, and
22 Verhalen Declarations. None of these actually state when an adequate disclosure of the claimed
23 inventions was made. Even taking them at face value, because they are stated in a range, the earliest
24 date they support is the end of "mid-1989." Charitably, this would be June 30, 1989. As such, even
25 accepting that the June 13, 1989 document is sufficiently detailed to support conception by that date,
26 applying the required rule of reason analysis Mr. Firoozmand clearly predates 3Com's alleged
27 invention.
28

1 **2. The SUPERNET 2 Chipset is Prior Art.**

2 3Com fails to rebut the uncontested evidence that the SUPERNET 2 chipset was offered for
3 sale more than a year before its patent applications were filed, nor that the chipset included every
4 element of its asserted patent claims.

5 **(a) Realtek’s Evidence that SUPERNET Was On Sale Is Clear and**
6 **Convincing and Is Unrebutted.**

7 3Com incorrectly applies the law of evidence in a futile attempt to deny that the SUPERNET 2
8 chipset was offered for sale in February 1991. In a well-known periodical published and circulated in
9 February 1991, AMD offered to sell the SUPERNET 2 chipset at a stated price for a given quantity.
10 Firoozmand ’872 and ’094 Decl., Ex. 9. 3Com attempts to dismiss this offer as hearsay, but it is
11 mistaken. The magazine article is self-authenticating. F.R.E. 902. It is not hearsay because Realtek
12 offers this document to prove simply that the statement was made – that AMD offered to sell the
13 SUPERNET 2 chipset. Thus, this document is not hearsay and conclusively establishes that the chipset
14 was offered for sale in February 1991. The same is true of the magazine published by AMD for its
15 customers. As such, 3Com has failed to rebut the evidence of invalidating offers for sale under 35
16 U.S.C. § 102(b).

17 **(b) Realtek’s Evidence Of The Actual Structure of SUPERNET 2 Is**
18 **Competent and Unrebutted.**

19 The undisputed evidence establishes that the relevant anticipating features of the SUPERNET 2
20 chipset were part of Mr. Firoozmand’s initial conception of that product in or before 1988.
21 Firoozmand ’872 and ’094 Decl., ¶ 6. They were fully disclosed in his May, 1990 patent applications
22 and spelled out in detail in the 1991 datasheets accompanying the commercial release of that product.
23 *Id.*, ¶¶ 5-6, Exs.1-2, 8. Based on this evidence there can be no genuine issue that the SUPERNET 2
24 chipset as offered for sale in 1991 contained those elements. 3Com does not rebut any of this
25 evidence. Rather, it focuses only on the datasheets, and argues that because they are not definitively
26 dated at the time of the offer for sale, there is insufficient evidence to demonstrate the features of the
27 product that were present at the time of that February 1991 offer. In order to prevail on that argument
28 3Com essentially argues that the “parallel tasking” features, which were part of Mr. Firoozmand’s
initial concept for this product as early as 1988, that are described as features of the FORMAC Plus

1 chip in the May, 1990 patent applications were filed, and are fully described in the product datasheets
2 as revised in the fall of 1991 were somehow taken out of the product for a brief time in early 1991, but
3 put back in a few months later. That argument is based on speculation only. There is simply no
4 evidence.

5 **3. The Firoozmand Patents Are Not Limited to FDDI, and SUPERNET 2**
6 **Chipset Disclose Every Limitation of the Asserted Claims of the Parallel**
7 **Tasking Patents**

8 3Com attempts to avoid this invalidating prior art by raising a brand new and utterly baseless
9 argument -- that “all of the asserted claims of the Parallel Tasking patents” require *Ethernet* network
10 transceivers. Opp’n at 8. 3Com provides no support for this statement, because there is none. With
11 the exception of claim 21 of the ’872 patent and claim 28 of the ’094 patent, there is no limitation
12 whatsoever on the network protocol in any of the asserted claims. For example, claim 1 of the ’459
13 patent refers simply to a “network transceiver.” Likewise, none of claims 1 and 10 of the ’872 patent
14 nor claims 1, 9, 21, 39 and 47 specify any network protocol. Nowhere in the Court’s claim
15 construction Order are these claims so limited, and in fact 3Com never asked for such a restrictive
16 interpretation. 3Com must not be permitted to avoid summary judgment by attempting to confuse the
17 court with reference to non-existent claim limitations. Because claims are interpreted the same for
18 infringement as for invalidity, the Court must disregard all of 3Com arguments regarding the supposed
19 differences between FDDI and Ethernet protocols.

20 **(a) Firoozmand and the SUPERNET 2 Include the “Initiating**
21 **Transmission” Limitation**

22 3Com argues that the Firoozmand patents and the SUPERNET 2 chipset fail to meet the
23 “initiating transmission” limitation in each of the asserted claims. Opp’n at 7. However, 3Com’s
24 argument is based entirely on the allegedly “fundamental differences” between adapters for FDDI
25 networks and Ethernet network adapters. Opp’n at 7. That entire argument is irrelevant as a matter of
26 law. With the exception of claims 28 of the ’872 patent and claim 21 of the ’094 patent, the asserted
27 claims are not limited to Ethernet adapters. As such, any alleged distinction between these claims, the
28 Firoozmand prior art and Ethernet adapters is irrelevant. This argument should therefore be
disregarded. Moreover, as discussed below with respect to these two particular claims, 3Com’s expert

opinion on these allegedly “radical differences” are demonstrably false. As such, this limitation is literally present in the Firoozmand patents and the SUPERNET 2 chipset.

(b) Firoozmand and the SUPERNET 2 Include the Bad Frame Signal Limitation of Claim 1 of the '872 Patent and Claim 21 of the '094 patent

3Com’s argument with respect to the “bad frame signal” is also utterly without basis in law or fact. The “bad frame signal” is a requirement of Claim 1 of the '872 patent and claim 21 of the '094 patent. 3Com does not actually challenge the presence of this claim element in either the Firoozmand patents or the SUPERNET 2 chipset.. Opp’n at 13. That is likely because its own expert expressly admitted as much:

Q. Dr. Williams, in the FDDI protocol, when a frame is aborted is there any information or signal going out on the communication medium?

MR. KONRAD: Object to the form.

THE WITNESS: *There's a bad-frame signal supplied to the medium, yes.*

Declaration of Sean P. DeBruine in Support of Realtek’s Reply in Support of Motion for Summary Judgment of Invalidity (“DeBruine Decl”), Ex. A (Williams Tr. at 174:24- 175:1 (emphasis added)). In light of this sworn admission there can be no triable issue of fact. *Disc Golf Ass’n, Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1008 (9th Cir. 1998) (“party cannot create a triable issue of fact, and thus survive summary judgment, merely by contradicting his or her own sworn deposition testimony with a later declaration”); *Radobenko v. Automated Equip. Corp.*, 520 F.2d 540, 543-44 (9th Cir. 1975) (“a party cannot create an issue of fact by an affidavit contradicting his prior deposition testimony”).

Rather than directly contradict the admitted presence of this claim limitation in the prior art, 3Com somehow argues that the Firoozmand patents “Teach away” from the asserted claims. That argument is irrelevant as a matter of law. Realtek argues that these claims are anticipated, which 3Com does not genuinely challenge. “Teaching away” is irrelevant to the anticipation analysis. *Celeritas Techs., Ltd. v. Rockwell Int’l, Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). This is just another example of 3Com’s attempt to avoid the clear invalidity of its patent claims by raising legally irrelevant arguments.

1 (c) **The Firoozmand Patents and SUPERNET 2 Disclose “Posting Status**
2 **Information” as Required by Claim 10 of the ’872 Patent and Claims**
3 **21 and 47 of the ’094 Patent**

4 3Com’s argument that Firoozmand and the SUPERNET 2 do not disclose posting status
5 information similarly ignores the claim limitations as construed by this Court. There is no dispute that
6 Firoozmand patents and the SUPERNET 2 chipset set an underrun bit, which can be read by the host.
7 Firoozmand ’872 and ’094 Decl., ¶ 11. There is no dispute that this host-readable information may be
8 used to optimize the threshold value. *Id.* Quite clearly a threshold value that results in repeated
9 underrun conditions is not optimal. 3Com points to no evidence to the contrary. Rather, its expert
10 opines that Firoozmand did not disclose “how to provide a host with enough information to change the
11 threshold value based on real-time operating conditions.” Williams Decl., ¶ 32. In other words, Dr.
12 Williams reads the claim to require *dynamic* altering of the threshold value, that reading was opposed
13 by 3Com and rejected by the this Court in its claim construction. Claim Construction Order at 11.
14 Similarly, the Court expressly rejected Realtek’s reading of the claims to require that the threshold
15 value be altered more than once. *Id.* at 12-13. Again, because this opinion does not address the claim
16 limitation in light of the Court’s claim construction, it is irrelevant to the anticipation analysis.

17 (d) **Firoozmand and the SUPERNET 2 Include the Network Interface**
18 **Logic and Threshold Logic Limitations of Claim 1 of the ’459 patent**

19 3Com argues that the evidence proffered by Realtek fails to establish the existence of the either
20 the “network interface logic” or the “indication signal” limitations of claim 1 of the ’459 patent in the
21 Firoozmand patents or the SUPERNET 2 prior art. Opp’n. at 13-14. 3Com’s argument with regard to
22 the “network interface logic” is based on the false premise that the “network transceiver” required by
23 this claim element is limited to *Ethernet* transceivers. Opp’n. at 13. Again, there is nothing in claim 1
24 that expressly limits the recited “network transceiver” to and “*Ethernet* network transceiver.” Claim 1
25 is limited 3Com fails to explain how that can be the case, since the very evidence cited by 3Com stands
26 for the shows that these claim limitations are, in fact, disclosed in that prior art. As disclosed in the
27 Firoozmand I patent, in response to a threshold determination the FORMAC Plus chip 120 generates
28 the RDATA signal. In the preferred embodiment that signal is sent to the DMA controller 124. The
DMA controller interfaces with the host and indicates to the host when there is data in the buffer
memory to be transferred to the host. The description of DMA controller 124 confirms what one of

1 ordinary skill in the art would know – that the DMA controller communicates with the host CPU by
2 asserting and de-asserting interrupt. Firoozmand '872 and '094 Decl., Ex. 1 at 12:25-31. With respect
3 to the SUPERNET 2 chipset, after RDATA is asserted, a host acknowledge signal is returned that starts
4 the transfer of data from the buffer to the host. As Mr. Firoozmand explained, there can be no such
5 acknowledgement from the host without a first interrupt to the host. It is the interrupt that is
6 acknowledged by the host signal. Cole Decl., Ex. 2 at 197-198. Thus, there is no genuine dispute that
7 the Firoozmand patents and SUPERNET 2 chipset disclose both the “network interface logic” and the
8 “indication signal” limitations.

9 Thus, there is no actual dispute that the RDATA signal is an indication signal and it is followed
10 by an interrupt.

11 **4. Firoozmand and the SUPERNET 2 Chipset Disclose CSMA/CD Networks,**
12 **Invalidating Claim 28 of the '872 Patent and Claim 21 of the '094 Patent.**

13 As discussed above, the alleged differences between FDDI networks and Ethernet networks are
14 relevant only to claim 28 of the '872 patent and claim 21 of the '094 patent. Those claims, and only
15 those claims, are limited to NICs designed for a Carrier Sense Multiple Access/Collision Detection
16 (“CSMA/CD”) networks. Firoozmand '872 and '094 Decl., Ex. 6 ('872) and 7 ('094). Ethernet is one
17 form of a CSMA/CD network. 3Com argues that Firoozmand and the SUPERNET 2 chipset do not
18 disclose CSMA/CD networks because they were conceived and designed for use in FDDI networks.
19 This is not true with respect to the Firoozmand patents, which expressly state they apply to other
20 network formats. With respect to the SUPERNET 2 chipset, this argument is irrelevant.

21 A prior art reference anticipates a claim if it discloses every element of the claim to one of
22 ordinary skill in the art. As such, the relevant inquiry includes the words used by the reference and the
23 knowledge of one skilled in the art. *In re Graves*, 69 F.3d 1147 (Fed. Cir. 1995), *cert. denied* 517 U.S.
24 1124 (1996). Thus a reference will anticipate where every element of the claim is disclosed, even if it
25 then disparages the claimed invention. *Id.* Here, the Firoozmand patents expressly state that the FDDI
26 implementation is nothing more than a preferred embodiment, and that the parallel tasking circuits and
27 methods in that patent are applicable to “[v]arious types of network controller architectures . . . based
28 on the network operating system employed and on other considerations.” Firoozmand '872 and '094
Decl., Ex. 1 at 1:57-60. As such, Firoozmand I ('749) expressly teaches that it “has general

1 applicability in the field of framed or packet data manipulation” and it is *not limited* to FDDI
2 networks. *Id.* at 6:63-68. 3Com’s characterization of these teachings as “boilerplate” is irrelevant.
3 That characterization can not and does not refute the teaching that the concepts disclosed in the
4 Firoozmand patents are “generally applicable” to networks using “frame[] or packet data.” *Id.* 3Com
5 does not, and can not, refute the fact that CSMA/CD networks such as the Ethernet standard were a
6 very common network controller architecture that manipulated data in frames or packets. As such,
7 there is no issue of fact. As a matter of law the Firoozmand patents disclose the parallel tasking
8 features for use with CSMA/CD networks.

9 **5. Using the SUPERNET 2 Parallel Tasking Features in an Ethernet Adapter**
10 **Would Have Been Obvious.**

11 3Com’s attempt to differentiate Ethernet and FDDI network standards is relevant only to the
12 issue of whether the asserted claims of the parallel tasking patents would have been obvious in light of
13 the prior art. Again, there is no genuine issue of fact to support 3Com’s argument to the contrary.
14 Based solely on the opinion of its expert, Dr. Williams, 3Com repeatedly argues that the FDDI
15 networks and Ethernet networks are “fundamentally different.” However, that statement does not stand
16 up to even the most cursory inspection.

17 In support of this assertion 3Com and its expert, Dr. Williams, argue first that FDDI and
18 Ethernet use “different transmission media.” Opp’n at 7; Williams Decl., ¶¶ 11-21. In particular, they
19 assert that FDDI uses optical fibers, while Ethernet uses copper cable. Williams Decl., ¶¶ 13-14. That
20 assertion is simply false and made without regard to any of the objective contemporaneous evidence of
21 record. First, this assertion simply ignores the 3Com’s own patents, which are expressly disclosed as
22 applicable for use with any transmission media, including “coaxial cable, a twisted pair conductor, a
23 fiber optic, satellite, wireless or other communication medium. Firoozmand ’872 and ’094 Decl., Ex.6
24 (’872) at 4:3-7 (emphasis added). FDDI networks could be implemented using either “fiber optic, or
25 copper twisted pair” as a transmission medium. *Id.*, Ex. 8 (Supernet datasheet) at RT008840 (citing
26 ANSI X3T9.5 FDDI standard); see also Firoozmand Rebuttal Decl., ¶ 4.

27 Next, 3Com asserts that transmission of data onto the physical medium (fiber or copper wire)
28 will not occur in an FDDI network unless the adapter has the “token.” Opp’n at 8. While that is true,
this fact is neither relevant, nor does it differentiate the two network types. First, the asserted claims

1 do not require “immediate transmission” onto the physical medium. In fact, the claims refer to
2 “initiating” that transfer, which connotes a number of steps that culminate in the actual transmission of
3 the data. Again 3Com is arguing new claim limitations not in the Court’s claim construction order and
4 not in any way justified by the intrinsic evidence. For this reason alone this alleged difference may be
5 disregarded. Even so, this alleged difference simply does not exist. In the FDDI environment, the first
6 step in initiating transfer of data onto the physical medium is to check for the token. Firoozmand
7 Rebuttal Decl., ¶ 4. If the token is present, transmission begins immediately. If the adapter does not
8 have the token, it waits until it is received and then transmits. *Id.* In this there is no difference
9 between FDDI and Ethernet. In Ethernet, the first step in initiating data transmission is to check the
10 network for availability. *Id.* If access is granted, transmission begins immediately. If not, the adapter
11 waits for the network to clear before data is put onto the medium. *Id.* Thus, in both cases the first step
12 after transmission is initiated is to check whether data may be transmitted immediately. *Id.* There is
13 simply no factual basis to argue any relevant differences between the two network standards.

14 Finally, 3Com’s entire argument that one skilled in the art would consider the two standards
15 incompatible is belied by the simple fact that, in order to achieve the increased speed demanded by
16 users, the Ethernet standard adopted the FDDI encoding schemes and transceiver specification as the
17 Ethernet standard. Firoozmand Rebuttal Decl., ¶ 5. Thus, Dr. Williams’ opinions are unfounded.
18 They can not, as a matter of law, raise any genuine issue of material fact. Based on the objective facts,
19 as shown in 3Com’s own patents and in the contemporaneous industry standard publications, there was
20 little if any difference between the two network standards, and no differences that would teach away
21 from using the parallel tasking inventions made by Firoozmand in a CSMA/CD network environment.

22 Thus, the facts, rather than Dr. Williams’ objectively baseless opinion, disclose that there was
23 no difference between the prior art and the claimed inventions. The Firoozmand patents contain an
24 express suggestion to alter the SUPERNET 2 and to implement the Firoozmand patents in a
25 CSMA/CD network environment. 3Com’s alleged secondary considerations are insufficient to
26 overcome this showing. First, 3Com fails to establish the required nexus between the any of the patent
27 claims and the alleged commercial success. *See In re GPAC*, 57 F.3d 1573 (Fed. Cir. 1995). As such,
28 the record is devoid of evidence as to what weight to give this evidence for any one of the many

different inventions in the asserted claims. In addition, 3Com fails to show that the commercial success is attributable to the patents at all, rather than cost (“the goal of the Vulcan project was to develop a *very low cost adapter*,” Scherer Decl., ¶9) or the popularity of Ethernet networks over FDDI networks due to their lower cost. *Id.*, see also Firoozmand Decl., Ex. 9 (2/81 LAN article). 3Com presents no evidence to show that others attempted but failed to make the invention or the alleged long-felt need in the industry. Finally, as discussed above 3Com’s argument that Firoozmand “teaches away” from the invention or that the invention is counter to the conventional wisdom in the industry has no basis in fact. As such this attempted showing is insufficient to overcome Realtek’s prima facie showing that the claims are, at a minimum, obvious.

B. Claim 26 of the ’446 Patent Is Invalid Over the Osborne Patent

3Com’s attempt to dispute the invalidity of claim 26 of the ’446 patent in light of the Osborne prior art is similarly without basis. 3Com’s argument ignores the fundamental premise that a prior art reference must be examined for its entire disclosure. It is error to limit the disclosure of a prior art patent to its preferred embodiment. *Arthrocare Corp. v. Smith & Nephew, Inc.*, 406 F.3d 1365, 1372 (Fed. Cir. 2005) (citing *Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1068 (Fed. Cir. 1997)). 3Com here invites just that error. It contends that the Osborne prior art discloses data segmentation by the host. Opp’n. at 16. While that citation is correct as far as it goes, it describes only one embodiment disclosed by Osborne. Elsewhere in the patent Osborne expressly states that frame segmentation occurs in the network interface controller (NIC). See Firoozmand ’446 Decl., ¶ 8 (quoting Osborne ’915 Patent at 20:8-14). 3Com does not dispute this disclosure, it simply ignores it. However, ignoring it does not make it go away, and does not raise an issue of fact. On the undisputed evidence, claim 26 of the ’446 patent is anticipated as a matter of law.

C. Claim 1 of the ’884 Patent Is Invalid Over the Boucher and Muller II Patents.

1. The Muller Patent Is Prior Art

As with the Firoozmand patents discussed above, the application for the Muller patent was filed before the application for the ’884 patent. As such, it is presumed to be prior art. In order to overcome that presumption, 3Com bore the burden of coming forward with evidence sufficient to show either that 1) it has actually reduced the claimed invention to practice before the March 1, 1999 filing date of

1 the Muller application; or 2) that its inventors had conceived of the invention prior to the Muller
2 application *and* its inventors were diligent in working to reduce the invention to practice from a time
3 just before the Muller filing until their own reduction to practice. *Mahurkar*, 79 F.3d at 1576. 3Com
4 has come forward with no evidence whatsoever to demonstrate the required diligence. Its opposition
5 brief is silent on this issue. Because there is no evidence whatsoever to support a finding of diligence,
6 Realtek is entitled to summary determination that the Muller patent is indeed prior art.

7
8 **2. The Muller Patent Discloses Every Limitation of Claim 1**

9 3Com fails to raise any genuine issue with regard to the anticipation of claim 1 of the '884
10 patent in light of the Muller II patent. First, 3Com argues that Muller II does not disclose the “packet
11 filter” limitation, citing its expert’s declaration. Opp’n at 18; Williams Decl., ¶¶ 47-48. However, Dr.
12 Williams has never before expressed or even hinted at such an opinion. In his expert report he
13 nowhere addresses the “packet filter” limitation. DeBruine Decl., Ex. B. Similarly, while Dr.
14 Williams did previously address the “second logic” element, the basis for his present opinion is not
15 disclosed in his report. Rather, his new opinion that Muller does not disclose the “second logic” relies
16 entirely on his new opinion that the “packet filter” is not met. Williams Decl., ¶ 49. Because this new
17 basis for his opinion was not disclosed in his expert report, as required by Fed. R. Civ. P. 26(f) and this
18 Court’s scheduling order, and because Realtek is prejudiced by not being able to cross-examine Dr.
19 Williams on those basis or prepare a rebuttal, paragraphs 47-49 of the Williams declaration should be
20 stricken.

21 Even if allowed, this argument is yet another irrelevant straw man 3Com sets up and knocks
22 down. Again, 3Com argues that its '884 patent is somehow limited to Ethernet networks. *Id.* Again,
23 there is no such limitation in the patent or the claims and the claims have not been construed so
24 narrowly. In fact, the patent states that its scope is for an adapter card for any “network or other
25 communication channel.” Neither 3Com nor its expert discusses the disclosure of the Muller II patent
26 in light of the claim language as construed by the Court. Because the patent as limited as 3Com would
27 have it, and because a comparison of a preferred embodiment of the patent, rather than the patent claim
28 itself, to the prior art is irrelevant for an anticipation analysis, the Court must simply disregard 3Com’s

entire argument. Realtek cites to evidence showing that every element of asserted claim 1, as construed by the Court, is disclosed in the Muller II prior art. Motion at 7; Firoozmand '884 Decl., ¶¶ 4-7. 3Com fails to rebut that showing, arguing only that the preferred embodiments of the two patents are different. That argument is insufficient to raise any genuine issue of fact. Therefore, summary judgment should be granted.

3. The Boucher Patent Discloses Every Limitation of Claim 1

The same is true of the Boucher prior art patent. Again, 3Com argues that Boucher does not disclose the processing of VLAN tags. Opp'n. at 19; Williams Decl., ¶ 50. Again, the "variant format" of data packets called out in the claim is not limited to VLAN tags. As such, the opposition fails to address the only relevant question. Realtek has established that Boucher does, in fact, process data packets having "variant formats" as actually required by the claim. Motion at 8-10; Firoozmand '884 Decl., ¶¶ 8-13. In the absence of any relevant argument or evidence to the contrary, summary judgment should therefore be granted on the Boucher prior art as well.

III. CONCLUSION

For the reasons discussed above and in Realtek's Motions for Summary Judgment of Invalidity of the '872, '094, '459, '446 and '884 patents, the motions should be granted.

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AKIN GUMP STRAUSS HAUER & FELD LLP

By: _____/s/
Elizabeth H. Rader
Attorneys For Defendant
REALTEK SEMICONDUCTOR CORPORATION